

**Response under 37 C.F.R. 1.116**

Applicant: Sterling Mortensen

Serial No.: 09/941,467

Filed: August 29, 2001

Docket No.: 10004428-1

Title: DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE

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**REMARKS**

The following Remarks are made in response to the Final Office Action mailed May 4, 2005, in which claims 1-10, 14-25, and 28-30 were rejected, and claims 11-13 and 26-27 were objected to. Claims 1-30 remain pending in the application and are presented for reconsideration and allowance.

**Examiner Interview**

Applicant thanks the Examiner for the courtesies extended to Applicant's representative, Scott Lund, during a telephonic interview conducted on June 29, 2005, during which Applicant's representative and the Examiner discussed the previously submitted Declaration of Prior Invention and the right of priority of the McCurdy et al. Patent Application, as outlined below. No agreement was reached at that time.

**Claim Rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103**

Claims 1-3, 14-20, 22, and 28-30 are rejected under 35 U.S.C. 102(e) as being unpatentable over McCurdy et al. US 2002/0035697. Claims 4-10 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCurdy et al. US 2002/0035697 in view of Beale, "Get Prepress-Ready PDFs from QuarkXPress".

McCurdy et al. has a publication date of March 21, 2002 and a filing date of July 2, 2001. Applicant previously submitted a Declaration of Prior Invention under 37 C.F.R. 1.131 to establish conception of the subject matter of the present patent application prior to the filing date of July 2, 2001 of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 coupled with due diligence from just prior to the filing date of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 up to the filing date of the present patent application (i.e., constructive reduction to practice).

The Examiner contends that the affidavit is ineffective to overcome the McCurdy reference on the basis that the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the McCurdy reference to either a constructive reduction to practice or an actual reduction to practice. More specifically, the Examiner contends that diligence is lacking from 6/18/2000 to 5/15/2001.

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Applicant notes that under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). MPEP 715.07 III and 715.07(a). In this instance, the effective date of the McCurdy reference is July 2, 2001 and the date of a reduction to practice is the filing date of August 29, 2001. Applicant submits that the activities of May 2001, June 2001, and July 2001 identified in Exhibits B-D of the previously submitted Declaration of Prior Invention establish diligence from a time just prior to the effective date of the McCurdy reference up to the filing date of the present patent application. Applicant, therefore, respectfully requests reconsideration of the Declaration of Prior Invention under 37 C.F.R. 1.131.

Applicant recognizes that the "Related U.S. Application Data" of the McCurdy et al. U.S. Patent Application does identify the McCurdy et al. U.S. Patent Application as a Non-Provisional of Provisional Application No. 60/215,683, filed on June 30, 2000. Applicant submits, however, that before the McCurdy et al. U.S. Patent Application can rely on June 30, 2000 as the earliest effective filing date, a determination must be made as to whether the subject matter used to make the rejection is appropriately supported in the replied upon earlier-filed application's disclosure (see MPEP 706.02(f)(1) and 706.02(i)).

Accordingly, Applicant submits that the Examiner must make a determination as to whether the subject matter used to make the rejection of claims 1-30 under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) is appropriately supported in Provisional Application No. 60/215,683. As such, Applicant respectfully requests that the Examiner provide a copy of Provisional Application No. 60/215,683, and identify where the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application.

The Examiner also contends that the affidavit is ineffective to overcome the McCurdy reference on the basis that a detailed constructive reduction to practice is unavailable in that nowhere in the affidavit was 'mobile computing device' disclosed. Applicant notes that a constructive reduction to practice occurs when a patent application on the claimed invention is filed (see MPEP 2138.05). In addition, an affidavit or declaration under 37 CFR 1.131 may establish possession of either the whole invention claimed or something falling within the claim (e.g., a species of a claimed genus), in the sense that the claim as a whole reads on it. MPEP 715.02. In this instance, the application as filed defined a 'mobile computing

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device' to include "any portable device which provides computing and information storage and retrieval capabilities" with the mobile computing device including, for example, "any small, hand-held device or appliance such as a personal digital assistant (PDA), pocket PC, connected organizer, electronic book (eBook) reader, or other handheld" (Specification page 4, lines 10-14).

Exhibit A of the previously submitted Declaration of Prior Invention identifies a computer, a printer, and an e-book and includes statements such as "[a] simple digital e-book doesn't need a complex rendering system," "[a] document can be rendered once and sent to many e-books," and "[e]veryone see's the document the same way even if they have e-books from different vendors." Similar to the phrases "computer" and "printer", the phrase "e-book" as used in Exhibit A, therefore, is referring to a device. As such, Exhibit A discloses a species (i.e., e-book) of a claimed genus (i.e., mobile computing device). Thus, Applicant submits that the filing of the application is a constructive reduction to practice. Applicant, therefore, respectfully requests reconsideration of the Declaration of Prior Invention under 37 C.F.R. 1.131.

In view of the above, Applicant submits that McCurdy et al. does not qualify as a reference under 35 U.S.C. 102(e) and, therefore, does not qualify as a reference under 35 U.S.C. 103(a). Applicant, therefore, respectfully requests that the rejection of claims 1-3, 14-20, 22, and 28-30 under 35 U.S.C. 102(e) and the rejection of claims 4-10, 21, 23, and 24-25 under 35 U.S.C. 103(a) be reconsidered and withdrawn, and that claims 1-30 be allowed.

**Allowable Subject Matter**

Claims 11-13 and 26-27 are objected to as being dependent upon a rejected base claim and are indicated as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Applicant agrees with the Examiner that claims 11-13 and 26-27 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. As outlined above, Applicant, however, has submitted a Declaration of Prior Invention under 37 C.F.R. 1.131 to establish conception of the subject matter of the present patent application prior to the filing date of July 2, 2001 of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 coupled with due diligence from prior to

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the filing date to the filing date of the present patent application (i.e., constructive reduction to practice). Applicant, therefore, respectfully requests that the objection to claims 11-13 and 26-27 be withdrawn and that claims 11-13 and 26-27 be allowed.

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In view of the above, Applicant respectfully submits that pending claims 1-30 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Response should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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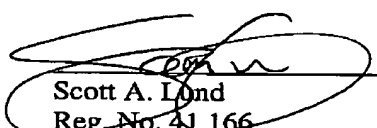
Respectfully submitted,

Sterling Mortensen,

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**CERTIFICATE UNDER 37 C.F.R. 1.8:** The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306 on this 5TH day of July, 2005.

By   
Name: Scott A. Lund